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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,094	10/13/2006	Dietmar Krautwurst	102790-211 (D30126 US)	4405
27389	7590	05/12/2010		
PARFOMAK, ANDREW N. NORRIS MCLAUGHLIN & MARCUS PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022			EXAMINER WEGERT, SANDRA L	
			ART UNIT	PAPER NUMBER
			1646	
			MAIL DATE	DELIVERY MODE
			05/12/2010 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/577,094

**Applicant(s)**

KRAUTWURST ET AL.

**Examiner**

SANDRA WEGERT

**Art Unit**

1646

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6 and 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7-11, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **Detailed Action**

#### ***Status of Application, Amendments, and/or Claims***

Claims 1-23, 26 and 27 are pending. Claims 2-4, 6 and 12-23 are withdrawn. The Amendment of 5 February 2010 has been entered in-part (see below). Claims 1, 5 and 8 have been amended.

Claims 1, 5, 7-11, 26 and 27 are being examined in the instant Office action.

### **Withdrawn Objections/Rejections**

#### ***Claim Rejections - 35 USC § 112- second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

The rejection of claim 1 and dependent claims under 35 U.S.C. 112, -second paragraph, for improper antecedence for "the olfactory receptors," is withdrawn based on applicants' amendment (5 February 2010).

The rejection of claim 8 for referring to a "potential recombinant specific G protein-coupled receptor" is *withdrawn*, based on applicants' amendment (5 February 2010).

#### ***Claim Rejections-35 U.S.C. 101, Product of Nature***

35 U.S.C. 101 reads as follows:

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

The rejection of claims 1, 5, 7-10, 26 and 27 under 35 U.S.C. § 101 is *withdrawn* based on applicants' amendment that inserted the word "isolated" into the independent claim (2 February 2010).

### **Maintained Objections/Rejections**

#### ***Specification-***

##### ***Figures/Brief Description***

The substitute page of the specification filed 5 February 2010 has not been entered because it does not conform to 37 CFR 1.125(b) because: An amendment directing entry of this paper into the instant Application must be submitted before it can be considered. The amendment should be specific as to which page or part of specification is to be replaced/amended. In addition, the amendment must be accompanied by a statement that the substitute page includes no new matter.

In addition, the corrected version of the Brief Description now lists Figure 10 as comprising parts (A) through (D) and yet the figure itself does not contain the identifiers (A) through (D). Appropriate correction is required.

##### ***Claim Rejections - 35 USC § 112- second paragraph***

The rejection of claims 1, 5, 7-10, 26 and 27 under 35 U.S.C. 112, second paragraph, is *maintained*. Claims 1, 5 and 8 no longer refer to "recombinant specific" G protein coupled receptors (per the amendment of 5 February 2010), but still refer to "specific" receptors. It is not

clear what is meant by "specific" or what distinguishes a "specific" G-protein coupled receptor from that which is not "specific".

### ***Deposit Information***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

**The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

Claim 11 *remains* rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The invention employs novel nucleic acid molecules (i.e., clone: DSM ACC2649). Applicants submitted the Deposit slip showing the deposit was made in the DSMZ depository. Although it is clear that the depository is recognized and approved by the World Intellectual Property Organization (WIPO), the International Depository Authority, and that the depository is valid under the Budapest Treaty, applicants or applicants' representative must also submit a statement or declaration that assures compliance with the rules governing biological deposits. The Assurance of compliance may be in the form of a declaration or averment under oath. A suggested format for such a declaration or averment:

A **Declaration** by applicant, assignee, or applicant's agent identifying a deposit of biological material and averring the following may be sufficient to overcome an objection and rejection based on a lack of availability of biological material.

1. Identifies declarant.

2. States that a deposit of the material has been made in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted. The depository is to be identified by name and address.

3. States that the deposited material has been accorded a specific (recited) accession number.

4. States that all restrictions on the availability to the public of the material will be irrevocably removed upon the granting of a patent.

5. States that the material has been deposited under conditions that ensure that access to the material will be available during the pendency of the patent application to one determined by the Commissioner to be entitled thereto under 35 CFR 1.14 and 35 USC 122.

6. States that the deposited material will be stored with all care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism, and in any case at least thirty (30) years after the date of a deposit or for the enforceable life of the patent, whichever is longer.

7. Acknowledges the duty to replace the deposit should the depository be unable to furnish a sample when requested due to the condition of the deposit.

8. That he/she declares further that all statements made therein of his/her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Conclusion:** Claims 1, 5, 7-11, 26 and 27 are rejected for the reasons recited above.

#### **Advisory information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (571) 272-0895. The examiner can normally be reached Monday - Friday from 9:00 AM to 5:00 PM (Eastern Time). If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Nickol, can be reached at (571) 272-0835.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (in USA or CANADA) or 571-272-1000.

/SLW/

6 May 2010

/Dong Jiang/  
Primary Examiner, Art Unit 1646